

## **REMARKS/ARGUMENTS**

Reexamination of the captioned application is respectfully requested.

### **A. SUMMARY OF THIS AMENDMENT**

By the current amendment, Applicant:

1. Thanks the Examiner for the indicated allowability of claims 6 – 10, 16, 22, 30, and 31.
2. Thank the Examiner for the allowance of claims 17-21, 23-25, 27 and 28.
3. Amends claims 28 and 32.
4. Adds new independent claim 38 (similar to existing independent claim 32).
5. Add new independent claim 39 (incorporating the subject matter of existing claims 32 and 36).
6. Respectfully traverses all prior art rejections (see §B infra).
7. Respectfully traverses the provisional obviousness type double patenting rejection (see §C infra) .

### **B. PATENTABILITY OF THE CLAIMS**

Claims 32-35 and 37 stand rejected under 35 USC §102(e) as being clearly anticipated by U.S. Patent 6,342,976 to Nomura et al.

As amended, independent claim 32, refers to the "first means" as being arranged beyond an outer edge of the focusing lens, and adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam. Independent claim 32 further specifies that the entire portion of the laser beam collected by the focusing lens is focused.

Nomura neither discloses nor suggests to provide diffraction gratings beyond the outer edge of the lens "base", which, according to the Examiner's interpretation, is the optical element and which corresponds to the focusing lens. In fact, Nomura discloses

forming the diffraction gratings by depositing a separate material on the portion 12 of the focusing lens, or by treating the peripheral portion 12 of the focusing lens itself (see col. 5, lines 60-61 and col. 6, lines 11-13). In both the cases, the diffracting portion is disposed on the surface of the lens (see col. 6, lines 18-19, 20-26, 34-35 etc.).

In other words, Nomura discloses providing, on the lens surface, a central portion 11 with no diffraction gratings and a peripheral portion 12 having diffraction gratings 12A (see col. 5, lines 44-47). Applicant's claim 32, by contrast, recites that the first means are arranged beyond the outer edge of the focusing lens, i.e., outside the surface of the focusing lens.

Thus, even giving to the claim 32 and Nomura a broad interpretation as made by the Examiner, it is evident that Nomura does not meet the claimed feature discussed above. Therefore, in view of the above and other considerations, claim 32 as now amended is novel over Nomura.

In further distinction from Nomura, the optical device of claim 32 does not require any machining or treatment of the lens surface to separate the central portion of the light beam from the surrounding portion thereof.

To further distinguish claim 32 over Nomura, claim 32 has been amended so that the entire portion of the laser beam collected by the focusing lens is focused.

Indeed, in the embodiment of Nomura device where the diffracting portion is disposed on the surface of the lens on the optical disk side and the laser beam has a wavelength of 780 nm, the peripheral portion of the light beam which is incident on the portion 12 of the lens 5 is not focused (it is diffracted sideways) and only the central portion of the light beam which is incident on the central portion 11 of the lens 5 is focused (see col. 4, line 56 to col. 5, line 14). Therefore, in this case, Nomura does not

meet the feature of claim 32 that the entire portion of the laser beam collected by the focusing lens is focused.

In the embodiment of Nomura device where the diffracting portion is disposed again on the surface of the lens on the optical disk side and the laser beam has a wavelength of 635 nm, the entire portion of the laser beam collected by the focusing lens is focused (see col. 5, lines 19-41). Therefore, in this case, Nomura does not meet the feature of claim 32 that the central portion of the laser beam is separated from the surrounding portion thereof.

Finally, in the embodiment of Nomura device where the diffracting portion is disposed on the surface of the lens on the light source side (see col. 6, lines 33-37), Nomura does not meet the feature of claim 32 that the diffraction means are arranged beyond the outer edge of the focusing lens.

Independent claim 32 as now amended is neither anticipated or rendered obvious over Nomura. Indeed, in the device of claim 32 the first means, being not part or disposed on the focusing lens, can be integrally molded with the focusing lens by a method which is cheaper than that of Nomura.

New claim 38 specifies that the first means and the focusing lens are distinct from one another and are arranged in the single optical element such that they are never adjacent along any direction of propagation of the laser beam within the single optical element. These limitations are clearly supported from the drawings of the application.

As to new claim 38, it should be noted that Nomura discloses a optical device wherein the focusing lens and the diffraction gratings are always adjacent along any direction of propagation of the laser beam. This is because the diffraction gratings are created or disposed on the peripheral region of the focusing lens and, therefore, the light

beam which is incident on the diffraction gratings always comes from the adjacent peripheral region of the focusing lens wherein the diffraction gratings are disposed or created, or in the case where the diffracting gratings are disposed or created on the surface of the lens on the light source side, the light beam which is incident on the diffraction gratings always passes through the adjacent peripheral region of the focusing lens wherein the diffraction gratings are disposed or created.

In view of the above, the Applicant's invention as recited in new claim 38 is novel over Nomura. As to the non-obviousness, the same considerations set forth above in respect to amended claim 32 apply.

#### **C. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION**

Claims 1, 2, 4, 5, 11 - 15, 29, 32 - 36 are again provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims of US Patent application Serial Number 09/773,384. The provisional obviousness-type double patenting rejection is inappropriate, particularly since (as explained in section B hereof) all claims are now allowable. The application thus stands without any rejection other than the obviousness-type double patenting rejection, in which case the last two paragraphs of MPEP §804(I)(B) are operative. The obviousness-type double patenting rejection thus should be withdrawn.

Without conceding any issue of obviousness either now or in the future, Applicant does not waive the right or possibility of filing in the future a Terminal Disclaimer in the captioned application in order to expedite prosecution of the captioned application.

#### **D. MISCELLANEOUS**

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued

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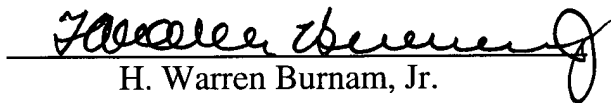
pendency of the captioned application, including but not limited to additional claims fee and the extension of time fee.

Should the Examiner feel that an interview with the undersigned would facilitate allowance of this application, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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